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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,892	06/29/2001	Hideaki Ono	50195-261	4949

7590

09/27/2002

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EXAMINER

SHEEHAN, JOHN P

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 09/27/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding..

# Office Action Summary

Applicati n No.

09/893,892

Applicant(s)

ONO ET AL.

Examiner

John P. She han

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 5-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1 to 4 and 13 in Paper No. 4, submitted September 13, 2002 is acknowledged. The traversal is on the ground(s) that a product and its method of preparation constitute a single inventive concept and that both sets of claims should be examined in a single application. Applicants also state that the Examiner's reason for the restriction requirement, that the process could be used to make another product or that the product could be made by a materially different process is not sufficient to meet the requirements of MPEP 806.05(f). This is not found persuasive because, although the applicants consider the method and product as a single inventive concept, MPEP 806.05(f) does permit restriction between a product and a process of making the product. Further, although applicants have made the general allegation that the Examiner's reasons for the restriction requirement are insufficient, applicants have not clearly and specifically pointed out why the Examiner's reasons for the restriction are insufficient. Finally, to examine both sets of claims in the same application would require not only additional searching but also would require consideration of additional 112 issues, prior art, formulation of rejections, etc.

The requirement is still deemed proper and is therefore made FINAL.

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Specification***

2. The attempt to incorporate subject matter into this application by reference to Japanese Application No. P2000-195890 (see specification page 17, lines 25 to 27) is improper because the incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

If the subject matter incorporated from Japanese Application No. P2000-195890 is not essential subject matter then applicants should so state on the record.

***Claim Objections***

3. Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is

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required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In independent claim 1 lines 2 and 3, the claimed powder is claimed as containing "a rare earth metal element". In view of the use of the word "a" the claimed powder is considered to contain a single rare earth. However, in dependent claim 3 the rare earth component is claimed as "at least one element selected from the group consisting of neodymium (Nd), praseodymium (Pr) and samarium (Sm)" that is, contrary to claim 1 claim 3 recites that there can be more than one rare earth in the claimed magnetic material. Accordingly, claim 3 does not further limit independent claim 1 but rather attempts to broaden the claimed subject matter.

***Claim Rejections - 35 USC § 112, 1<sup>st</sup> Paragraph***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1 to 4 and 13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Throughout the specification it is disclosed that the claimed magnetic powder is made by a sequence composed of "an amorphousing process and a crystallizing process" (for example, see the specification page 3, lines 6 to 10) an "amorphousing treatment and crystallizing treatment each at

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least once" (page 7, lines 30 to 31). Although applicants indicate that each of "amorphousing" treatment and crystallizing treatment are accomplished by known methods applicants have not specifically explained how these known methods of making an amorphous alloy and a crystalline alloy from the amorphous alloy are repeated on the same alloy. For example, an amorphous alloy can be made by melt spinning (page 8, lines 6 to 10) or other means (page 8, lines 23 to 29) and the crystallizing treatment can be accomplished by heat treatment (page 8, lines 30 to 35). However, it is not clear if this heat treatment is applied to the entire alloy or how the heat treated alloy is subsequently given an "amorphousing" treatment. Is the alloy melt spun again? Are the just formed crystals made amorphous again? Finally, it is not clear what the meaning is of the terms "amorphousing" (used throughout the specification as indicated above in this paragraph) and "amorphism" (page 12, the last line).

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- I. In claim 13, lines 1 to 3, the meaning of the phrase, "obtained by treatment, in an anisotropy-imparting molding process and a solidification process" is not clear. What does this phrase mean?

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

9. Claims 1 to 4 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Nomura et al. (Nomura, US Patent No. 6,261,385).

10.

Nomura teaches an anisotropic nanocomposite rare earth permanent magnet consisting of a hard magnetic phase and a soft magnetic phase (column 3, lines 28 to 35). Nomura defines the crystal size of a nanocomposite as being "several tens of nanometers" (column 2, lines 40 to 45) which overlaps the crystal size range of "150 nm or less" recited in the instant claims. Nomura teaches that the hard magnetic phase can contain at least one rare earth, a transition metal and N or B (column 4, lines 37 to 43) and that the soft magnetic phase can contain a transition metal and B (column 4, lines 48 to 51). Nomura also teaches preferred combination of phases that are

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encompassed by the instant claims (column 4, line 60 to column 5, line 3). Nomura teaches that this magnetic material can be ground to form an anisotropic nanocomposite powder (column 8, lines 1 to 5). Finally, Nomura teaches specific example alloys that are encompassed by the instant claims (column 9, Examples 2 to 6).

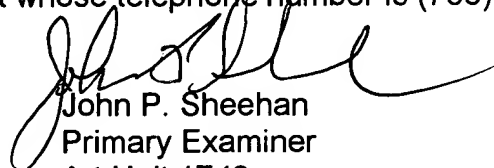
Applicants' claimed invention does not distinguish over the powder taught by Nomura.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (703) 308-3861. The examiner can normally be reached on T-F (6:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

  
John P. Sheehan  
Primary Examiner  
Art Unit 1742

jps  
September 25, 2002